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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/069,057 | 09/03/2002 | Franz Haimerl | FA/220 B | 9049 |

7590

04/11/2006

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/069,057 | HAIMERL, FRANZ | |
| | Examiner | Art Unit | |
| | Marie Patterson | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 37, 38, 67 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 37, 38, 67, and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election of Species IV, figure 7 in the reply filed on 5/17/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 9-36, 39-66, and 68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/17/04.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 37, 38, 67, and 69 are rejected under 35 U.S.C. 103(a) as obvious over Haimerl (5285546) in view of either Nowicki (5939488) or Muller (5019638).

Haimerl '546 shows a shoe and inherent/obvious process of making said shoe comprising an upper having an outer material (12a) and a functional layer (16), an outsole (14), and an adhesive zone comprising a hot melt adhesive/sealing substance (24 and/or 25) and the outsole is cemented to the upper (at 26) substantially as claimed except for the exact hot melt adhesive/sealing substance. Official notice is taken that

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reactive hot melt polyurethane adhesives are well known as adhesives which are also sealing agents. Either Nowicki or Muller provides evidence of the official notice and clearly state that the use of reactive hot melt adhesives are well known in the art of footwear, see Nowicki column 6 lines 53-67 and Muller column 3 lines 31-60. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any known polyurethane based adhesive/sealing agent including reactive hot melt adhesive as clearly taught by either Nowicki or Muller, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claim 7, see figure 7 of Haimerl. In reference to claim 8, see figure 1.

Response to Arguments

5. Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive. .

In response to applicants' arguments directed towards the property of reactive hot melt adhesives, waterproof/water resistant sealing is an inherent property of the reactive hot melt adhesive. Nowicki clearly states "Reactive hot melts...excellent moisture and chemical resistance." (see column 1 lines 27-33). It is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corporation v. Brenner, 156 USPQ 163, 854 OG 844). A patent cannot be granted for an appellants' discovery of a result, even though it may be

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unexpectedly good, which flows, as it does in this case, logically from the teachings of the prior art. (In re Inman, 43 CCPA 706, 228 F2d 226, 108 USPQ 138; In re Tancynn, 44 CCPA 764, 241 F2d 731, 112 USPQ 483; In re Kelly 43 CCPA 816, 230 F2d 435, 109 USPQ 42). Haimerl clearly suggests the use of a "polyurethane sealing agent or ..a moisture-hardening polyurethane sealing agent". Bothe Muller and Nowicki teach types of polyurethane sealing agents which are known to be used in footwear.

The cited reference to Tada (6087463) has been cited as an additional showing of inherency of reactive hot melt adhesives being known as sealing agents, note column 2 lines 1-3 and lines 20-25.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728